

DOCKET NO: 246242US2

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
HIROYUKI SHIBAKI, ET AL. : EXAMINER: KAU, S.Y.
SERIAL NO: 10/727,663 :
FILED: DECEMBER 5, 2003 : GROUP ART UNIT: 2625
FOR: IMAGE PROCESSING :
APPARATUS, IMAGE PROCESSING
SYSTEM, AND IMAGE PROCESSING
METHOD

PROVISIONAL ELECTION

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the communication mailed June 14, 2007, and the Election of Species Requirement contained therein, Applicants hereby provisionally elect the Species of scanner noted in the Requirement as "II. Claims 20-27 & 52-59" and that were said to "define a species of an image processing apparatus comprising an input unit." In further accordance with the Requirement, Applicants list Claims 20-27 & 52-59 as reading of these corresponding provisionally elected species.

Besides making this provisional election, Applicants traverse the Requirement for several reasons.

First, the requirement violates MPEP 806.04(f) that states:

Where two or more species are claimed, a requirement for restriction to a single species may be proper if the species are mutually exclusive. Claims to different species are mutually exclusive if one claim recites limitations disclosed for a first species but not a second, while a second claim recites

limitations disclosed only for the second species and not the first. (Emphasis added).

Clearly, provisionally elected Claims 20-27 & 52-59 do not recite limitations that are “mutually exclusive” relative to Claims 1-19, 28-33, or 34-46 as all of these claims recite the limitations noted as characterizing the provisionally elected species in terms of reciting “an image processing apparatus comprising an input unit.” In addition, provisionally elected Claims 20-27 & 52-59 are further not mutually exclusive as to Claims 28-33 that are characterized as defining species “III” that is said to “define a species of an image processing apparatus comprising an input unit, a magnification unit and an image processing unit.” Provisionally elected Claim 20 clearly **DOES NOT EXCLUDE** this subject matter as it recites “an image processing apparatus comprising an input unit and a magnification unit” and is a “comprising” claim that **DOES NOT EXCLUDE** the image processing unit of Claim 28.

As this required mutual exclusivity between the asserted species is clearly lacking, this Election Requirement is clearly improper and should be withdrawn.

In addition, as there is clearly a disclosed relationship between Claims 1-19, Claims 20-27 & 52-59, Claims 28-33, Claims 34-46 & 60-65, and Claims 47-51. For example, FIG. 1 shows the subject matter of combination Claim 1 that is an image processing unit that includes the input unit and, thus, embraces the subject matter noted as to species II as well as part of the subject matter noted as to species III and species IV. In addition, Claim 1 recites the first and second segmentation units, the color component control unit and an image processing unit that are listed as also being embraced by species IV. While Claim 1 does not specifically recite any magnification unit, it also does not exclude one. In any event, the outstanding Requirement is clearly one made in error as it makes no attempt to follow MPEP § 808.01(a) that requires all disclosed relationships between asserted species to be “**discussed**

and reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction” as follows:

Where there is a relationship disclosed between species, such disclosed relation must be discussed and reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction, in order to establish the propriety of restriction.

As this required discussion and reasons have been omitted, this Election Requirement is further clearly improper and should be withdrawn for this reason as well.

In addition, MPEP § 809.02(a)(B) has been violated as it is clear that no figures were used to identify the species even though such figures are clearly present. In this regard, this section notes that when they are present, figures identifying the species are to be used as follows:

(B) Clearly identify each (or in aggravated cases at least exemplary ones) of the disclosed species, *to which claims are to be restricted*. The species are preferably identified as the species of figures 1, 2, and 3 or the species of examples I, II, and III, respectively. In the absence of distinct figures or examples to identify the several species, the mechanical means, the particular material, or other distinguishing characteristic of the species should be stated for each species identified.

It is only when these preferred modes for identifying the species are not available that the use of claim numbers is permitted by this section (“[i]f the species *cannot be conveniently identified*, the claims may be grouped in accordance with the species to which they are restricted.).

As the required modes for identifying the asserted species are absent and have not been used, this Election Requirement is further clearly improper and should be withdrawn for this reason as well.

Finally, applicants traverse the requirement for failing to comply with the guidelines set forth in MPEP §803 that indicate that:

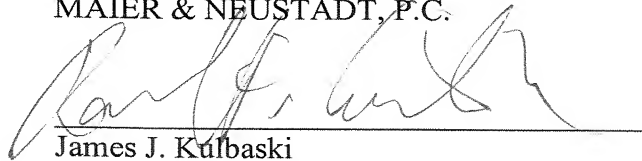
If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.

Here, it is clear that a complete search of provisionally elected Claims 20-27 & 52-59 will overlap the search areas for the non-elected claims and that computerized searching introduces no extra examination burden as to non-overlapping search areas. Accordingly, there will be no serious search and examination burden present here as to examining all of pending Claims 1-65.

Accordingly, it is respectfully requested that the election of species requirement be withdrawn for all of the reasons noted above and that an examination of all of Claims 1-65 be provided.

Respectfully submitted,

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